

## REMARKS

This application has been reviewed in light of the Office Action dated June 7, 2006. Claims 1-15 are pending. Claims 1, 7, 13 and 14, the independent claims, have been amended to define still more clearly what Applicant regards as his invention. Favorable reconsideration is respectfully requested.

In the Office Action, previously-allowed Claims 1-15 were rejected solely under 35 U.S.C. § 101 as allegedly lacking in patentable utility. The only basis stated for this rejection is that in the claimed subject matter (apparatus, method and computer-readable storage medium) “a series of step are taken in acquiring various forms of information, which in itself does not produce a tangible result.”

After a thorough study of the Office Action, the present specification and claims, and the MPEP, Applicant finds that he cannot agree that the outstanding rejection is proper.

The MPEP explains the requirement that an application discloses some real-world utility, referred to sometimes as producing a tangible result:

“The claimed invention as a whole must accomplish a practical application. That is, it must produce a ‘useful, concrete and tangible result.’ *State Street*, 149 F.3d at 1373, 47 USPQ2d at 1601-02. The purpose of this requirement is to limit patent protection to ***inventions that possess a certain level of ‘real world’ value, as opposed to subject matter that represents nothing more than an idea or concept, or is simply a starting point for future investigation or research*** (*Brenner v. Manson*, 383 U.S. 519, 528-36, 148 USPQ 689, 693-96); *In re Ziegler*, 992, F.2d 1197, 1200-03, 26 USPQ2d 1600, 1603-06 (Fed. Cir. 1993)). Accordingly, a complete disclosure should contain some indication of the practical application for the claimed invention, i.e., why the applicant believes the claimed invention is useful. [emphasis added]”

In the present application, the real-world value of the present invention is the acquisition of information that is needed by an administrator in the course of managing a network, and the presentation of that information to the administrator. Applicant does not see any basis on which this could be said to lack real-world value. (If the Examiner disagrees, he is respectfully requested to elaborate on his view.)

The MPEP adds that something more than real-world usefulness is required to meet the statutory-subject-matter requirement:

“Apart from the utility requirement of 35 U.S.C. 101, usefulness under the patent eligibility standard requires *significant functionality to be present* to satisfy the useful result aspect of the practical application requirement. See *Arrhythmia*, 958 F.2d at 1057, 22 USPQ2d at 1036. *Merely claiming nonfunctional descriptive material stored in a computer-readable medium does not make the invention eligible for patenting. For example, a claim directed to a word processing file stored on a disk may satisfy the utility requirement of 35 U.S.C. 101 since the information stored may have some ‘real world’ value. However, the mere fact that the claim may satisfy the utility requirement of 35 U.S.C. 101 does not mean that a useful result is achieved under the practical application requirement.* The claimed invention as a whole must produce a ‘useful, concrete and tangible’ result to have a practical application. [italicizations added; underlining original]”

Applicant believes that it goes without saying that the pending claims are not directed merely to “claiming nonfunctional descriptive material stored in a computer-readable medium”. Thus, it is believed to be plain that each of Applicant’s independent claims (and therefore also the dependent claims) is directed to statutory subject matter, and that the rejection should be withdrawn.

Moreover, Applicant notes the following two examples of an acceptably “useful, concrete and tangible” result cited in the MPEP:

“‘[T]ransformation of data, representing discrete dollar amounts, by a machine through a series of mathematical calculations into a final share price, constitutes a practical application of a mathematical algorithm, formula, or calculation, because

it produces 'a useful, concrete and tangible result' -- a final share price momentarily fixed for recording and reporting purposes and even accepted and relied upon by regulatory authorities and in subsequent trades.' *State Street*, 149 F.3d at 1373, 47 USPQ2d at 1601; and

- Claims drawn to a rasterizer for converting discrete waveform data samples into anti-aliased pixel illumination intensity data to be displayed on a display means were held to be directed to patentable subject matter since the claims defined 'a specific machine to produce a useful, concrete, and tangible result.' *In re Alappat*, 33 F.3d 1526, 1544, 31 USPQ2d 1545, 1557 (Fed. Cir. 1994).“

Further:

“A process that consists solely of the manipulation of an abstract idea is not concrete or tangible. See *In re Warmerdam*, 33 F.3d 1354, 1360, 31 USPQ2d 1754, 1759 (Fed. Cir. 1994). See also *Schrader*, 22 F.3d at 295, 30 USPQ2d at 1459. Office personnel have the burden to establish a *prima facie* case that the claimed invention as a whole is directed to solely an abstract idea or to manipulation of abstract ideas or does not produce a useful result. ***Only when the claim is devoid of any limitation to a practical application in the technological arts should it be rejected under 35 U.S.C. 101.*** Compare *Musgrave*, 431 F.2d at 893, 167 USPQ at 289; *In re Foster*, 438 F.2d 1011, 1013, 169 USPQ 99, 101 (CCPA 1971). Further, when such a rejection is made, Office personnel must expressly state how the language of the claims has been interpreted to support the rejection. [bold italicization added; underlining original]“

In Applicant's claims, the information gathered is information about the state and operation of a piece of hardware (including, possibly, software running on the hardware), and is provided to an administrator to help the administrator to do his or her job or maintaining the network in operation at an acceptable level. This is as “concrete and tangible” as the two examples quoted from the MPEP. Moreover, it would be entirely incorrect to say that the claimed subject matter is “devoid of any limitation to a practical application in the technological arts”. (Again, if the Examiner disagrees, he is respectfully requested to explain in detail the basis for his view.)

Moreover, the MPEP provides the following commentary on machines that are statutory under 35 U.S.C. § 101:

**“(a) Statutory Product Claims**

Products may be either machines, manufactures, or compositions of matter. A *machine* is "a concrete thing, consisting of parts or of certain devices and combinations of devices." *Burr v. Duryee*, 68 U.S. (1 Wall.) 531, 570 (1863).

A *manufacture* is "the production of articles for use from raw or prepared materials by giving to these materials new forms, qualities, properties or combinations, whether by hand labor or by machinery." *Chakrabarty*, 447 U.S. at 308, 206 USPQ at 196-97 (quoting *American Fruit Growers, Inc. v. Brogdex Co.*, 283 U.S. 1, 11 (1931)).

A *composition of matter* is "a composition of two or more substances [or] . . . a[] composite article, whether [it] be the result[] of chemical union, or of mechanical mixture, or whether . . . [it] be [a] gas[], fluid[], powder[], or solid[]." *Id.* at 308, 206 USPQ at 197 (quoting *Shell Development Co. v. Watson*, 149 F. Supp. 279, 280, 113 USPQ 265, 266 (D.D.C. 1957), *aff'd per curiam*, 252 F.2d 861, 116 USPQ 428 (D.C. Cir. 1958)).

***If a claim defines a useful machine or manufacture by identifying the physical structure of the machine or manufacture in terms of its hardware or hardware and software combination, it defines a statutory product.*** See, e.g., *Lowry*, 32 F.3d at 1583, 32 USPQ2d at 1034-35; *Warmerdam*, 33 F.3d at 1361-62, 31 USPQ2d at 1760.

Office personnel must treat each claim as a whole. The mere fact that a hardware element is recited in a claim does not necessarily limit the claim to a specific machine or manufacture. Cf. *In re Iwahashi*, 888 F.2d 1370, 1374-75, 12 USPQ2d 1908, 1911-12 (Fed. Cir. 1989), cited with approval in *Alappat*, 33 F.3d at 1544 n.24, 31 USPQ2d at 1558 n.24.

***A claim limited to a machine or manufacture, which has a practical application in the technological arts, is statutory.*** [bold italicizations added; other italicizations original]“

From this, Applicant believes that it is plain that his apparatus claims (Claims 1-6, 14 and 15) are statutory.

Again, the MPEP gives a number of examples of statutory processes:

“Examples of this type of claimed statutory process include the following:

- A computerized method of optimally controlling transfer, storage and retrieval of data between cache and hard disk storage devices such that the most frequently used data is readily available.
- A method of controlling parallel processors to accomplish multi-tasking of several computing tasks to maximize computing efficiency. See, e.g., *In re Bernhart*, 417 F.2d 1395, 1400, 163 USPQ 611,616 (CCPA 1969).
- A method of making a word processor by storing an executable word processing application program in a general purpose digital computer's memory, and executing the stored program to impart word processing functionality to the general purpose digital computer by changing the state of the computer's arithmetic logic unit when program instructions of the word processing program are executed.” *Ibid.*

A process that assists a network administrator in monitoring a network and its components by using software to gather network information needed for that purpose is as much a useful, real-world process that is not merely a manipulation of numbers of abstract ideas as are a word-processing program or controlling a system of parallel-processors. This analysis is believed to apply to method Claims 7-12, and to Claim 13 (to a computer-readable storage medium storing a program for performing such method) as well.

For all these reasons, it is believed to be clear that Claims 1-15 comply fully with all requirements of Section 101, and that the Office Action fails to set out even a plausible basis for a rejection under that Section.

The newly added claims in this application are each dependent from one or another of the independent claims discussed above and are therefore believed patentable for the same reasons. Since each dependent claim is also deemed to define an additional

aspect of the invention, however, the individual consideration of the patentability of each of the new claims on its own merits is respectfully requested.

In view of the foregoing amendments and remarks, Applicant respectfully requests favorable reconsideration and allowance of the present application.

Applicant's undersigned attorney may be reached in our New York Office by telephone at (212) 218-2100. All correspondence should continue to be directed to our address listed below.

Respectfully submitted,

/Leonard P Diana/  
Leonard P. Diana  
Attorney for Applicant  
Registration No. 29,296

FITZPATRICK, CELLA, HARPER & SCINTO  
30 Rockefeller Plaza  
New York, New York 10112-3801  
Facsimile: (212) 218-2200

NY\_MAIN 590405v1